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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,309	02/21/2002	Michael Brandt	20859	3846

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HOFFMANN-LA ROCHE INC.
PATENT LAW DEPARTMENT
340 KINGSLAND STREET
NUTLEY, NJ 07110

EXAMINER

CHANDRA, GYAN

ART UNIT	PAPER NUMBER
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1646

MAIL DATE	DELIVERY MODE
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04/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/081,309

Applicant(s)

BRANDT ET AL.

Examiner

Gyan Chandra

Art Unit

1646

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 April 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 5, 6, 8 and 12-15.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: see PTO- 892.


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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Continuation of 11 does not place the application in condition for allowance because:

Claims 1, 3 and 5-15 are pending.

Claim 4 has been canceled. The amendments of claims 1, 13 and 14 have been entered.

Claims 3, 7 and 9-11 are withdrawn.

Claims 1, 5-6, 8 and 12-15 are under examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-6, 8, and 12-13 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Date et al (Oncogene, 17:3045-3054, 1998) in view of Bartley (US Patent No. 5,766,581) for the reasons of record on pg. 3-5 of the office action mailed on 7/26/2006.

Applicants reiterate their previous arguments (filed on 10/17/2006) that (i) the reference Barley only teaches pegylation of megakaryocyte growth and development factors (MGDFs) and that there is no apparent teaching of peg-modification of any other protein. Applicants cite Mehvar (2000), Francis et al (1998) and Reddy (2000) to support that the art of pegylation is unpredictable. Applicants now argue (page 7 of Response) that neither Date nor Bartley teach modifying any protein including even MGDF above 25 kDa.

Applicant's arguments regarding the reference Bartley that the reference does not teach pegylation of any other other protein have been fully considered but they are not persuasive for the reasons of record on pages 3-4 of the previous Office Action of 01/03/2007. Applicants' arguments that neither Date nor Bartley teach the recited limitation of a PEG molecule having a molecular weight from about 30 to about 40 kDa, are not persuasive because Bartley teaches attaching a PEG molecule of molecular weight 12-25 kDa and further, suggests that a polymer of any molecular weight can be attached with a protein of interest (col. 21, line 47). It is well known in the art that a PEG molecule of molecular weight 2-100 kDa can be attached to achieve a desired result (see- US Patent No. 6,586,398, specifically, claims 3-4). Therefore, the rejection is maintained.

Claims 14 and 15 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Date et al and Bartley et al as applied to claims 1-2, 4-6, 8, and 12-13 above, and further in view of and further in view of Veronese et.al. (US Patent 6,528,485) for the reasons of record on pages 5-6 of the office action mailed on 7/26/2006.

Applicants reiterate their previous arguments (filed on 10/17/2006) that the Veronese reference does not overcome the deficiencies of Date in combination of Bartley. Applicants argue that Veronese does not provide motivation to combine Date and Bartley. Applicant's arguments have been fully considered but they are not persuasive for the reasons of record on pages 4-5 of the previous Office Action of 01/03/2007. Further, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).